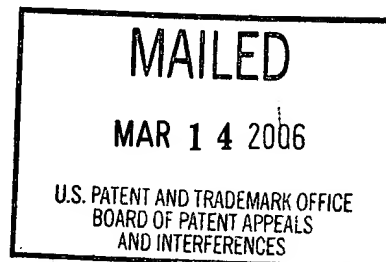


UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Jeffrey H. Price

Appeal No. 2005-2269
Application No. 09/837,871



ON BRIEF

Before BARRETT, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1, 2, 4-10, 12, 16, 17, 21-24, and 26.¹ The appellant appeals therefrom under 35 U.S.C. § 134(a).² We affirm.

¹The examiner explains that claims 3, 11, 13-15, 18-20, 25, and 27-29 are objected to as depending on a rejected base claim, "but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Examiner's Answer at 2.)

²The appellant also asks the "Board . . . instruct the Examiner to indicate allowance of these claims." (Examiner's Answer at 14.) Although the Board has jurisdiction to "review adverse decisions of examiners upon applications for patents," 35 U.S.C. §6(b) (2005), we have no authority to instruct a patent examiner to indicate allowance of claims.

I. BACKGROUND

The invention at issue on appeal generates three-dimensional ("3D") images of a sample. Images of biological samples can be used for diagnostic and prognostic purposes. For example, technicians observing images of biological samples may identify cancerous tissues. In such cases, explains the appellant, 3D images often contain information unavailable in a two-dimensional image. (Spec. at 1.)

Unfortunately, he adds, conventional technology for creating 3D images results in a trade-off "between scanning speed and resolution." (*Id.*) Specifically, he explains that the time required to develop 3D images having a "desired degree of resolution is so long as to make these images impractical for use in diagnostic and prognostic settings." (*Id.*)

Accordingly, the appellant has invented a system for microscopic imaging of a sample in a volume. The system includes plural detectors, each focused at a respective focal plane within a sample volume. The focal plane of each detector can be positioned at a different distance from a sample holder. Because each detector is focused at a different depth in the sample volume, a 3D image of the sample can be obtained by combining the image from each detector. (*Id.* at 4.) The appellant alleges

that his system "affords an increase in image resolution without a sacrifice in scan speed." (Appeal Br. at 6.)

A further understanding of the invention can be achieved by reading the following representative claims.

1. A system for imaging of a sample, comprising:

a plurality of detectors which are each focussed at a respective focal plane in a sample volume; and

light selection optics positioned between the plurality of detectors and the sample volume, the light selection optics for transmitting to the detectors a portion of light originating at the respective focal planes while screening out light which originates from outside of the respective focal planes.

10. The system of claim 1, further comprising:

focus differentiation optics which causes each detector to be focussed at different depths within the sample.

Claims 1, 2, 4-10, 12, 16, 17, 21-24, and 26 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,024,283 ("Campanelli").

II. OPINION

Our opinion addresses the claims in the following order:

- claims 1, 2, 4-9, 16, 17, 21-24, and 26
- claims 10 and 12.

A. CLAIMS 1, 2, 4-9, 16, 17, 21-24, AND 26

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7)). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, the appellant stipulates that claims 1, 2, 4-9, 16, 17, 21-24, and 26 "stand or fall together." (Appeal Br. at 9.) We select claim 1 from the group as representative

of the claims therein. With this representation in mind, rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the two points of contention therebetween.

1. Detectors Having Focal Distances

The examiner correctly finds, "Campanelli teaches . . . each group of detector elements having an associated predetermined operating focal distance (see Col. 7, lines 22-26)." (Examiner's Answer at 7.) The appellant argues, "the embodiment of Campanelli illustrated in FIG. 3b is structured and operated to select one focal distance and to operate at that one focal distance." (Appeal Br. at 10.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated.

a. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664,

1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations: "a plurality of detectors which are each focussed at a respective focal plane. . . ." We agree with the examiner that the claim "does not recite the plurality of detectors focused at *different* focal planes, which is the basis for Applicant's arguments, but merely that each detector contains an associated focal plane." (Examiner's Answer at 7.) Giving the representative claim its broadest, reasonable construction, therefore, the limitations require plural detectors, each having a focal plane.

b. Anticipation Determination

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002).

[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). "A reference anticipates a

claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. "' *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Here, we find that Campanelli "provides a bar code reader for reading a symbol located at a distance from the reader. . . ." Col. 7, ll. 23-25. Because the reader "includ[es] an array of groups of reading elements," *id.* at ll. 24-25, i.e., "an array of detector elements," col. 10, l. 42, we also find that the reference teaches plural detectors. Because "each group [of detector elements] ha[s] an associated predetermined operating focal distance," col. 7, ll. 25-26, we further find that each detector has a focal plane.

2. Sample Volume

The examiner correctly finds, "Campanelli et al. teach (see Fig. 3b) a system and method for imaging of a sample comprising a plurality of detectors (45) each focused at a respective focal plane in a sample volume (43) (see Col 7, lines 23-27). . . ." (Examiner's Answer at 3.) The appellant argues, "Campanelli omits a 'sample volume'. . . ." (Appeal Br. at 11.)

a. Claim Construction

Claim 1 further recites in pertinent part the following limitations: "a sample volume." Giving the representative claim its broadest, reasonable construction, the limitations require a volume of space in which a sample is located.

b. Anticipation Determination

For our part, we find that the symbol read by Campanelli's bar code reader is located in a volume of space. Therefore, we affirm the anticipation rejection of claim 1 and of claims 2, 4-9, 16, 17, 21-24, and 26, which fall therewith.

B. CLAIMS 10 AND 12

The appellant does not argue the patentability of claim 12 separately. Furthermore, claim 12 depends from claim 10. Therefore, we select claim 10 as representative of both claims.

The examiner correctly finds, "Campanelli et al. teach (see Fig. 3b) focus differentiation optics . . . which causes each detector to be focused at different planes (see Col. 7, lines 30-34) within the sample." (Examiner's Answer at 4.) The appellant argues, "Campanelli omits 'focus differentiation optics'." (Appeal Br. at 11.)

1. Claim Construction

"An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel* 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, claim 10 recites in pertinent part the following limitations: "focus differentiation optics which causes each detector to be focussed at different depths within the sample." Because the prepositional phrase "within the sample" merely states an intended use or purpose for the focus differentiation optics and the detectors, the phrase is not entitled to patentable weight. Giving the representative claim its broadest, reasonable construction, therefore, the limitations require optics for focusing detectors at different focal depths.

2. Anticipation Determination

Anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade*

Comm'n, 808 F.2d 1471, 1479 & n.11, 1 USPQ2d 1241, 1245 & n.11 (Fed. Cir. 1986)).

"An anticipatory reference . . . need not duplicate word for word what is in the claims."

Standard Havens Prods. v. Gencor Indus., 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).


Here, we find that Campanelli discloses that "[a] corresponding array 46 of focusing lens . . . may be used in connection with the array [of detectors 45] so that specific detector elements in the array 45 are associated with a lens element of a specific optical characteristic . . . e.g., focal length. . . ." Col. 7, ll. 11-15. We also find that "[t]he matching of detector elements and lens elements may be used to more accurately image the symbol 43 on the array 45 in circumstances when the symbol 43 is situated at an arbitrary or unknown distance from the array, or the plane of the symbol is positioned in a skewed manner with respect to the plane of the array." *Id.* at l. 21.

Because the reference's array of focusing lenses are used for focusing specific detector elements at specific focal lengths, we further find that lenses constitute optics for focusing the detectors at different focal depths. Therefore, we affirm the anticipation rejection of claim 10 and of claim 12, which falls therewith.

III. CONCLUSION

In summary, the rejection of claims 1, 2, 4-10, 12, 16, 17, 21-24, and 26 under § 102(b) is affirmed. "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

Lee E. Barrett
LEE E. BARRETT


LANCE LEONARD BARRY
Administrative Patent Judge

Howard B. Blankenship
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